

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 1, 6, 7, 16-18, 20, 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over JP 02000279418A to Suzuki (hereinafter “Suzuki”) in view of U.S. Patent No. 5,782,834 to Lucey et al., (hereinafter “Lucey”).¹ Furthermore, the Examiner rejects claims 10, 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of U.S. Patent No. 6,066,102 to Townsend et al., (hereinafter “Townsend”). Lastly, the Examiner rejects claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of U.S. Patent No. 6,110,127 to Suzuki, (hereinafter “Suzuki ‘127”).

In response, Applicants respectfully traverse the Examiner’s rejections under 35 U.S.C. § 103(a) for at least the reasons set forth below.

As discussed in the response to the previous Official Action, the Examiner did not reject claim 17 in the Official Action and Applicant amended claim 1 to include the features of claim 17. In this regard, Applicant believed that the rejection of claim 18 at paragraphs 12 and 13 of the Official Action may have been intended to be a rejection of claim 17. In light of the Examiner’s mistaken rejection in the previous Official Action and Applicant’s reliance thereon, the Applicant submits that the present Official Action should not have been made final and requests that the finality of such Office Action be withdrawn.

Furthermore, Applicant respectfully submits that the Examiner’s rejection of claims 21 and 22 under 35 U.S.C. § 103(a) is defective since the same depend from claim 1 and include all of the limitations of claim 1. The rejection of claim 1 cites both Suzuki and Lucey,

¹ Although the Examiner rejects claim 17, the same was canceled in response to the previous Official Action.

while the rejection of claims 21 and 22, depending from claim 1, cites only Suzuki (as well as Townsend as allegedly disclosing the additional features recited in claims 21 and 22).

Similarly, Applicants respectfully submit that the Examiner's rejection of claim 19 under 35 U.S.C. § 103(a) is defective since the same depends from claim 1 and includes all of the limitations of claim 1. The rejection of claim 1 cites both Suzuki and Lucey, while the rejection of claim 19, depending from claim 1, cites only Suzuki (as well as Suzuki '127 as allegedly disclosing the additional features recited in claim 19).

Applicants respectfully submit that the Examiner has failed to make out a prima facie case of obviousness at least for claims 19, 21 and 22 and such defective rejections are additional reasons for requesting that the finality of the present Official Action is improper and must be withdrawn.

In response to the Examiners rejections of the claims, Applicant respectfully traverses the Examiner's rejections under 35 U.S.C. § 103(a) for at least the reasons set forth below. However, as discussed below, claims 1 and 10 have been amended to clarify the same.

Applicant respectfully submits that claims 1 and 10 recite at least two distinguishing features when the forceps are closed:

1. The second rocking axis and longitudinal axis of the sheath are substantially on a reference plane; and
2. The first rocking axis is not on the reference plane (e.g., the first rocking axis is offset with respect to the reference plane).

Suzuki shows, in Figure 2 (with the forceps being closed), (1) the second rocking axis not being in the same plane as the longitudinal axis and (2) the first rocking axis being

aligned with the longitudinal axis. Therefore, Suzuki does not disclose either of the features (1) or (2) listed above.

Lucey shows, in each of the figures, the second rocking axis being offset from the longitudinal axis (and therefore not being in the same plane). Therefore, although Lucey may show feature (2) listed above (see Figure 9), Lucey does not show feature (1). However, as discussed below, Lucey is improperly combined with Suzuki at least because Lucey is directed to a single rotating forcep jaw, while Suzuki is directed to each of two jaws being rotatable.

Therefore, Suzuki and Lucey, even if properly combined, fail to disclose or suggest each of the features listed above. Thus, neither Suzuki nor Lucey disclose or suggest all of the features of original claim 17, now recited in independent claims 1 and 10.

With regard to the rejection of claims 1, 6, 7, 16-18, 20, 23 and 24 under 35 U.S.C. § 103(a), independent claim 1 is not rendered obvious by the cited references because neither the Suzuki patent nor the Lucey patent, whether taken alone or in combination, teach or suggest a medical instrument having the features discussed above and recited in independent claim 1. Accordingly, claim 1 patentably distinguishes over the prior art and is allowable. Claims 6, 7, 16, 18, 20, 23 and 24, being dependent upon claim 1, are thus at least allowable therewith (claim 17 being previously canceled). Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1, 6, 7, 16-18, 20, 23 and 24 under 35 U.S.C. § 103(a).

With regard to the rejection of claim 10 under 35 U.S.C. § 103(a), independent claim 10 is not rendered obvious by the cited references because neither the Suzuki patent nor the Townsend patent, whether taken alone or in combination, teach or suggest a medical instrument having the features discussed above and recited in independent claim 10.

Accordingly, claim 10 patentably distinguishes over the prior art and is allowable.

Consequently, the Examiner is respectfully requested to withdraw the rejection of claim 10 under 35 U.S.C. § 103(a).

With regard to the rejections of claims 19, 21 and 22 under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 19, 21 and 22 are at least allowable as depending from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 19, 21 and 22 under 35 U.S.C. § 103(a). Furthermore, as discussed above, the Examiner has not made out a prima facie case of obviousness for claims 19, 21 and 22 at least because the features allegedly disclosed by Lucey in claim 1 are not set forth in the rejection of claims 19, 21 and 22.

Furthermore, the Applicant respectfully submits that there is no motivation or suggestion to combine the Suzuki and Lucey references and that their combination does not lead to a predictable variation of that disclosed in Suzuki. Thus, for at least the reasons set forth below, the Applicant respectfully submits that the rejections for obviousness under 35 U.S.C. 103(a) are improper and must be withdrawn.

In this regard, the Applicant respectfully submits that Lucey shows a single movable forceps while Suzuki shows two movable forceps and, therefore, those of ordinary skill in the art would not look to a (1) a device having a single movable forceps jaw to combine with the teachings of Suzuki which discloses two movable forcep jaws. Although feature (2) listed above may be shown in Lucey, such a feature is irrelevant for a single movable jaw where symmetry about the longitudinal axis for two movable jaws is not a design criteria. Where both forceps jaws are movable, the prior art treats the rotation of the same symmetrically about the longitudinal axis, as is shown in Suzuki. The teaching of feature (2) in a reference disclosing a

single rotatable forceps jaw is irrelevant to those skilled in the art designing a pair of rotatable forceps jaws. Thus, there is simply no motivation or suggestion to those of ordinary skill in the art at the time of the invention to combine the single rotatable forceps jaw instrument of Lucey with the pair of rotatable forceps jaws recited in claims 1 and 10. For at least the same reasons, the claimed “pair of forceps, each of which rocks individually around a respective first rocking axis” is not a predictable variation of the single movable forceps jaw disclosed in Lucey.

Thus, Applicant respectfully submits that the rejections of the claims under 35 U.S.C. § 103(a), is improper and must be withdrawn. In this regard, the Applicant respectfully submits that there is no motivation or suggestion to combine at least the Suzuki and Lucey references and the present claims are not a predictable variation of at least either of the Suzuki and Lucey references, individually or in combination.

Lastly, claims 1 and 10 have been amended to correct a minor error therein and to clarify the same. Specifically, claims 1 and 10 have been amended to clarify that the circular cross section is perpendicular to a longitudinal central axis of the circular-section portion. Such clarification is fully supported in the original disclosure. Thus, no new matter has been introduced into the disclosure by way of the present amendment to claim 1 and 10. Applicants respectfully submit that such clarification also does not raise a new issue and requests that the same be entered and considered by the Examiner.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference

with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

/Thomas Spinelli/

Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS:AE